



1574
644
PATENT
\$

PATENT
Customer No. 22,852
Attorney Docket No. 1197-227

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Shaun Jordan et al.) Group Art Unit: 1614
)
Application No.: 10/055,915) Examiner: Phyllis G. Spivack
)
Filed: January 28, 2002)
)
For: 5-HT_{1A} Receptor Subtype Agonist) Confirmation No.: 1488

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE

In the Office Action of December 15, 2004, the Examiner notes that claims 1-32 are pending, that claims 3-19 and 23-32 are withdrawn, and that claims 1, 2, 20-22 and 32 are rejected. However, the only claims still pending in this case are claims 1, 20 and 22. See Supplemental Reply to Office Action filed April 15, 2004. This is also consistent with the Examiner's Amendment of April 19, 2004 which apparently crossed in the mail with the Supplemental Reply. Thus this response will reply only to the rejections of claims 1, 20 and 22 since the rejections of claims 2, 21, and 32 are moot.

With the cancellation of claim 21 and the amendment of claim 22, as set forth in the Supplemental Reply filed April 15, 2004 and the Examiner's Amendment of April 19, 2004, it is believed claim 22 complies with the requirements of 35 U.S.C §112, second paragraph. Its withdrawal as a ground of rejection of the claims is therefore requested.

In the Office Action, the Examiner also rejected claims 1, 20, and 22 under 35 U.S.C. §103(a) for being obvious over U.S. Patent No. 4,734,416 to Banno et al. (hereafter Banno).

In response, attached is a Declaration under Rule 132 of T. Kikuchi, one of the inventors that demonstrates the superior effect of the present compound (aripiprazole) for the treatment of depression, compared to compounds disclosed in DE 2912105 C2 and DE 2912105 C3.

As noted in the Information Disclosure Statement filed simultaneously herewith and which includes copies of DE 2912105 C2 and DE 2912105 C3, these documents are the German counterparts of Banno. As also noted in the Information Disclosure Statement, DE 2912105 C2 and DE 2912105 C3 include many compounds that are not specifically disclosed in Banno. The "Test compound 1" in the Declaration corresponds to the compound of Ex. No. 317 of DE 2912105 C2 and Ex. No. 311 of DE 2912105 C3; namely 7-{3-[4-(2,3-dichlorophenyl)-1-piperazinyl]propoxy}-3,4-dihydrocarbostyrl.

The "Test compound 1" in the Declaration is within the scope of the generic formula disclosed in Banno, but the compound is not specifically disclosed in the reference. "Test compound 1" was chosen because it has the most structural similarity to the compounds of claim 1. This is because the difference between "Test compound 1" and the present compound (aripiprazole) lies only in the number of the carbon atoms in the alkoxy side chain, i.e., propoxy (-O(CH₂)₃-) in "Test compound 1" and butoxy (-O(CH₂)₄-) in the compound of claim 1.

The results in the Declaration indicate that the compound of the present invention, aripiprazole, has an improved effect on depression, while the comparative compound (Test compound 1) does not have an improved effect on depression.

Accordingly, it is submitted that neither the invention of claim 1, nor of claims 20 and 22 dependent therefrom, can be considered obvious over Banno. Its withdrawal as a ground of rejection of claims 1, 20, and 22 is therefore requested.

It is believed claims 1, 20, and 22 are in condition for allowance.

In the next communication from the Examiner it would be appreciated if she would confirm that the Amendment After Allowance filed June 9, 2004 has been entered in this case. This is necessary to correct typographical errors in the specification.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNMER, L.L.P.

Dated: June 13, 2005

By: 

Arthur S. Garrett
Reg. No. 20,338

Attachment: Declaration of Tetsuro Kikuchi

916543_1.DOC